

REMARKS

In the Office Action, Claims 30 and 33 were objected to and Claims 16-32, 34 and 35 were rejected under 35 U.S.C. §112, second paragraph. Claims 16, 18-25, 28, 32 and 33 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey et al. in view of Crane. Claim 17 was rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey et al. in view of Crane and further in view of Ward et al. And, claims 29-31 were rejected under 35 U.S.C.103(a) as being unpatentable over Bailey et al. in view of Crane and further in view of Cox.

In the Office Action, Claims 34, 35, 26 and 27 were indicated as being allowable if re-written to overcome the 35 U.S.C. §112, 2nd paragraph rejections.

Applicants have amended Claims 16, 30, 33, 34 and 35 to address the objections and Section 112, 2nd paragraph rejections raised by the Examiner.

The 35 U.S.C. 103(a) Rejections

In support of the rejection of Claims 16, 18-25, 28, 32 and 33 the Examiner states "It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify bailey et al. by adding the first abutment member of Crane to the top hook of Bailey et al., and adding the ~~second~~ abutment member of crane to the lower hook of Bailey et al., since Crane teaches that providing a bookmark with upper and lower character portions is beneficial for increasing the aesthetic appeal of the bookmark." (page 6, Office Action).

Applicants respectfully traverse the Examiner's position concerning combining Bailey et al. and Crane. First, Applicants submit that Crane does not teach or suggest abutment members. The drawing in Crane does not show abutment members. Assuming, arguendo, that Crane includes abutments, contrary to the position taken by the Examiner adding the abutments to the top and lower hooks of Bailey et al. will not result in the claimed invention. The withdrawal of the bookmark through the book would still be prevented by the hooks of Bailey et al. In such a combination the "abutments" of Crane would be mere ornamentation.

Therefore, Applicant respectfully submits that the combination of Bailey et al. and Crane does not result in the structure claimed in Claims 16, 18-25, 28, 32 and 33.

Furthermore, Applicants submit that the prior art of record teaches away from combining Bailey et al. and Crane. First, in those bookmarks having a three-dimensional figure at one end, where it is desired to maintain the bookmark in place it is configured to grasp or engage the page or pages of the book. Applicants refer the Examiner to Clowes, U.S. Patent No. D22,481, Heustis, U.S. Patent D 23,060 and Royle, U.S. Patent No. D 89,037. These bookmark patents teach to modify the "intermediate member" to engage the pages of the book and not to use the body of the three-dimensional figure to hold the bookmark in place.

Second, in those bookmarks which extend through the book and extend from both ends, the bookmarks include opposing hooks which similarly engage the pages or spine of the book. Applicants refer the Examiner to Bailey et al., Ward et al. and Krause, U.S. Patent no. 4,462,614. There is no teaching or suggestion in the prior art to replace the hooks of Bailey et al., Ward et al. and Krause with three-dimensional figures to hold the bookmarks in place.

For the reasons stated above in connection with Claims 16, 18-25, 28, 32 and 33, Applicants submit that the Examiners rejection of Claim 17 is misplaced and should be withdrawn. Moreover, Ward et al. relied upon by the Examiner teaches the use of hooks to hold the bookmark in place.

Similarly, the Examiner's rejection of Claims 29-31 are misplaced for the reasons discussed above. Additionally, Applicants submit that the Examiner's reliance on Cox is inapposite. As shown in Cox, when used in its proper orientation it appears that the figure portion would be at the bottom of the book and therefore not used to retain the bookmark in the book.

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION:

Please enter the following new paragraph at page 1 of the specification.

--This application is a continuation application of Application Serial No. 09/136,348, filed on August 19, 1998, now abandoned.--

IN THE CLAIMS:

16. (Twice Amended) A bookmark for use in between pages of a book having a spine and a binding comprising:
a flexible, elongated, intermediate member having a first end and an opposing second end, said member having a predetermined length and thickness, said thickness [and] being of a size 5 to allow said intermediate member to extend between the pages of the book and along the length of the spine of the book without stretching its binding;
a top anchor having a thickness greater than the thickness of the intermediate member and being in the form of a portion of a character including a head end secured to said first end;
a bottom anchor having a thickness greater than the thickness of the intermediate 10 member and being in the form of a second portion of said character secured to said second end;

wherein the length of said intermediate member may be extended from its predetermined length to accommodate books of different sizes; and

wherein said anchors inhibit removal of the bookmark in a direction parallel to the length of the spine when the bookmark [book] is inserted within said book [therein].

30. (Twice Amended) A [new] bookmark for insertion between the pages of a book including a spine and comprising:

a thin, flexible, elongated connector having a first end and an opposing second end, said connector having a predetermined length;

5 a three-dimensional, first stop in the form of a figure having an upper torso supporting a head and a pair of forelimbs located at said first end of said connector;

a three-dimensional second stop in the form of a lower torso portion of said first stop including a retention member for retaining a coiled portion of said connector located at said second end of said connector; and

10 wherein said stops inhibit the removal of the bookmark in a direction substantially parallel to the length of the spine when the bookmark is inserted between pages of the book.

32. (Amended) A bookmark for use in between pages of a book having a spine and a binding comprising:

a flexible, elongated, intermediate member having a first end and an opposing second end, said member having a predetermined length and thickness, said thickness [and] being of a size

5 to allow said intermediate member to extend between the pages of the book and along the length of the spine of the book without stretching its binding;

a top anchor having a thickness greater than the thickness of the intermediate member and being in the form of a portion of a character including a head end secured to said first end;

10 a bottom anchor having a thickness greater than the thickness of the intermediate member and being in the form of a second portion of said character complementing said first portion end secured to said second end; and

wherein said anchors inhibit removal of the bookmark in a direction parallel to the length of the spine when the [book is inserted therein] bookmark is inserted between the pages of the book.

33. (Amended) A [new] bracelet comprising:

a thin, flexible, elongated connector having a first end and an opposing second end, said connector having a predetermined length;

5 a three-dimensional, first member in the form of a figure having an upper torso supporting a head and a pair of forelimbs positioned at said first end of said connector;

a three-dimensional second member in the form of a lower torso portion of said first member positioned at said second end of said connector;

10 complimentary fastening means being provided on said first and second members wherein said connector may be wrapped around an individual's wrist and the fastening means engaged to form a bracelet.

34. (Amended) A bookmark for use in between pages of a book having a spine and a binding comprising:

a flexible, elongated, intermediate member having a first end and an opposing second end, said member having a predetermined length and thickness, said thickness [and] being of a size 5 to allow said intermediate member to extend between the pages of the book and along the length of the spine of the book without stretching its binding;

a top anchor having a thickness greater than the thickness of the intermediate member and being in the form of a first portion of a character including a head end secured to said first end;

10 a bottom anchor having a thickness greater than the thickness of the intermediate member and being in the form of a second portion of said character secured to said second end;

wherein the length of said intermediate member may be extended from its predetermined length to accommodate books of different sizes;

wherein said anchors inhibit removal of the bookmark in a direction parallel to the length of the spine when the [book is inserted therein] bookmark is inserted between the pages of 15 the book;

wherein said top anchor includes a first fastener element; and
said bottom anchor includes a second fastener element constructed for releasable engagement with said first fastener element; and
said first fastener element and said second fastener element comprise a snap.

35. (Amended) A bookmark for use in between pages of a book having a spine and a binding comprising:

a flexible, elongated, intermediate member having a first end and an opposing second end, said member having a predetermined length and thickness, said thickness [and] being of a size 5 to allow said intermediate member to extend between the pages of the book and along the length of the spine of the book without stretching its binding;

 a top anchor having a thickness greater than the thickness of the intermediate member and being in the form of a first portion of a character including a head end secured to said first end;

 a bottom anchor having a thickness greater than the thickness of the intermediate 10 member and being in the form of a second portion of said character secured to said second end;

 wherein the length of said intermediate member may be extended from its predetermined length to accommodate books of different sizes; and

 wherein said anchors inhibit removal of the bookmark in a direction parallel to the length of the spine when the [book is inserted therein] bookmark is inserted between the pages of 15 the book;

 wherein said top anchor includes a first fastener element; and

 said bottom anchor includes a second fastener element constructed for releasable engagement with said first fastener element; and

 said first fastener element is in the form of a series of hooks and said second fastener 20 is in the form of a pile material having a set of loops.

CONCLUSION

Applicants respectfully submit that the claims, as amended, are allowable over the cited art and are in condition for a Notice of Allowance. Applicants submit that there is no teaching or suggestion of Applicants' invention as claimed within the scope of the disclosures of the cited references or of any combination thereof, if suggested therein, without extensive modification and the exercise of inventive talent. It is respectfully requested that the application be passed to issue. If there are any issues which can be discussed in a telephone interview, the Examiner is requested to contact Applicants' attorney at (562) 432-0453, ext. 255.

Please charge any additional fees payable in connection with this Amendment to Deposit Account No. 21-0800.

Sincerely,

FULWIDER PATTON LEE & UTECHT, LLP



Gary M. Anderson
Registration No. 30,729

GMA:srp
Fulwider Patton Lee & Utecht, LLP
200 Oceangate, Suite 1550
Long Beach, California 90802
(562) 432-0453
Customer No: 27629